72. A method as recited in claims 66, in which the first object is a perfume.

73. A method as recited in claims 66, in which the first object is a human model.

74. A method as recited in claims 66, in which the first object is a game.

75. A method as recited in claims 66, in which the first object is a food.

76. A method as recited in claims 66, in which the first object is a piece of apparel.

REMARKS

Status of the Application

Upon entry of this amendment, Claims 14-66 are allowed, independent claims 1, 67-76 will have been amended, and, claims 1-76 remain pending in this case. Claims 1-13 stand rejected under 35 U.S.C. §101 as providing non-statutory subject matter for allegedly reciting non-functional descriptive material. Claims 1-13 also stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by each of United States Patents 6,448,987 (*Easty et al.*) and 6,356,971 (*Katz et al.*). Claims 67-76 stand rejected under 35 U.S.C. §112, First Paragraph, as allegedly containing subject matter which was not described in the specification in such a way as

to reasonably convey to one skilled in the art that the inventor(s), at the time that application was filed, had possession of the claimed invention.

In view of the foregoing amendments and following remarks, Applicants respectfully requests reconsideration of the present application and an early Notice of Allowance.

35 U.S.C. § 101 Rejection

Claims 1-13 stand rejected under 35 U.S.C. §101, as the claimed invention allegedly is directed to non-statutory subject matter. The Official Action states that the claimed invention recites non-functional descriptive material, i.e. mere data. Furthermore, the Official Action states that the material does not impart functionality to either the data or the computer system.

Applicants respectfully submit that the standard for determining whether an invention satisfies 35 U.S.C. § 101 is if the invention falls within one of the four categories defined by § 101. Specifically, Congress deemed the following to be the appropriate subject matter of a patent: processes, machines, manufactures, and compositions of matter. The Supreme Court has held that Congress chose the expansive language of 35 U.S.C. § 101 to include "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 308-309, 206 U.S.P.Q. 193, 192 (1980). In the context of computer-related inventions, M.P.E.P. § 2106 (IV)(A)(1)(b) provides guidance in determining whether the invention satisfies 35 U.S.C. § 101. Specifically, §2106 states "[d]escriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter ..." However, § 2106 goes further to state,

> Nonfunctional descriptive material may be claimed in combination with other functional descriptive material on a computer readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of non-statutory subject matter.

Moreover, in the context of claims that recite computer readable mediums having data structures, §2106 goes further to state that,

> [A] claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and thus is statutory.

The Federal Circuit has supported this notion holding that data structures are not analogous to printed matter (i.e. data structures do not merely constitute data). *In re Lowry,* 32 F.3d 1579, 1584.

Applicants respectfully submit that Claims 1-13 as originally filed meet the requirements proscribed in M.P.E.P. § 2106 to be deemed patentable subject matter under 35 U.S.C. 101. Specifically, Applicants, refer the Examiner to the functional limitations found in independent Claim 1, wherein the "information ... [is used] ... in selecting the first musical composition from among a plurality of other compositions that are similar to the first musical composition." Stated differently, the computer medium of independent Claim 1 provides descriptive data which is used (i.e. **performs the function**) in selecting (i.e. **of selecting**) the first musical composition from among a plurality of other musical compositions. Applicants respectfully submit that such

functional language provides "the necessary functional and structural interrelationship[s] to satisfy the requirements of 35 U.S.C. § 101.

Notwithstanding this reasoning, however, Applicants have amended, once again, independent Claim 1 to include additional structural and functional recitations in an effort to bring this case into allowance and to more clearly recite the function(s) performed on the claimed descriptive material to better satisfy the requirements set forth in M.P.E.P. § 2106 to meet 35 U.S.C. § 101. Specifically, claim 1 has been amended to recite a " ... computer readable medium having computer readable **instructions** ... for **selecting** the first musical composition from among the plurality of other musical compositions that are similar to the first musical composition."

Inasmuch as dependent Claims 2-13 depend from newly amended independent Claim 1, they too now meet 35 U.S.C. § 101.

From the foregoing, it is appreciated that claims 1-13 of the present application meet the requirements of 35 U.S.C. § 101. On this basis, Applicant respectfully requests that the 35 U.S.C. § 101 rejection be withdrawn.

35 U.S.C. § 112, Paragraph 1 Rejection

Claims 67-76 of the present application stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which allegedly was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Official

Action states that the disclosure does not disclose any methods related to the objects recited in these claims.

Applicants respectfully submit that the standard when determining whether a claimed invention fails to meet 35 U.S.C. § 112, paragraph one is "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1989). Applicants further submit that whenever the issue arises, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed. The subject matter need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement. M.P.E.P. § 2163.02.

The Official Action states that Claims 67-76 allegedly fail to meet the written description requirement as articulated by 35 U.S.C. § 112, paragraph one because "the disclosure does not disclose any methods related to the objected recited [in claims 67-76]." Applicants respectfully disagree, and kindly refer to the "Summary of the Invention" and "Classifying Information" sections of the present application to offer proof that, indeed, methods reciting the objects described in claims 67-76 are disclosed in a manner that one skilled in the art would appreciate the invention as claimed at the time of the application.

Specifically, in the "Summary of the Invention", page 6, Lines 20-23, Applicants disclose the following method,

> [A] method is provided matching information that describes a first object to stored information that describes a plurality of other objects that are similar to the first object, wherein the stored information comprises a

> plurality of classification values that distinguish among features of similar kinds of objects.

It is clear that this method contemplates the use of various objects, not any particular object. With respect to the objects explicitly recited in Claims 67-76, Applicants refer to page 9, Lines 19-24 ("Classifying Information" section), wherein Applicants disclose explicitly the application of the inventive concepts (e.g. the above-described general objects method recited in the "Summary of the Invention" Section) to those objects explicitly recited in Claims 67-76. Specifically, in the "Classifying Information" section, Applicants state,

> the invention is not limited ... and is ... applicable to other information or objects that are normally difficult to classify or describe in objective terms. Examples of *other information or objects to which the invention may be applies include motion pictures, television programs, books, beverage, wine, works of art, perfume, game, food, piece of apparel, or even people, such as those who are fashion models, photographers' models, etc.*

Hence, as the subject matter need not be described literally, applying the method recitation found in the "Summary of the Invention" section to the "Classifying Information" section's recitation of various objects for which the described method may be applied, it is absolutely clear to one of skill in the art at the time of this application that Applicants regarded claims 67-76 as their invention. Stated differently, the present application discloses a method for classifying information about various objects, wherein the objects may include but are not limited to motion pictures, television programs, books, beverages, wine, works of art, perfume, game, food, piece of apparel, or even people such as those who are fashion models, photographers' models, etc.

Such recitation provides sufficient written description as articulated by the above-described standard to clearly convey to one skilled in the art the methods recited in claims 67-76.

Notwithstanding this reasoning, however, Applicants have amended claims 67-76 to more clearly recite the invention in an effort to bring this case into allowance.

From the foregoing, it is appreciated that claims 67-76 of the present application meet the requirements of 35 U.S.C. § 112, first paragraph. On this basis, Applicant respectfully requests that the 35 U.S.C. § 112, first paragraph rejection be withdrawn.

35 U.S.C. § 102(e) Rejection

Easty et al.

Claims 1-13 were rejected under 35 U.S.C. §102(e) as being allegedly anticipated by *Easty et al.* Applicants respectfully submit that the standard when determining whether a reference is anticipatory is: "... ***if the reference discloses, either expressly or inherently, every limitation of the claim.***" *Verdegaal Bros., Inc. v. Union Oil Co.,* 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). Moreover, "***[a]bsence from the reference of any claimed element negates anticipation.***" *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986).

Applicants respectfully submit that *Easty et al.* does not teach or suggest every limitation of the claims 1-13 of the present invention. Specifically, claims 1-13 of the present application are directed to an apparatus for use in matching similar or identical musical compositions using a

plurality of classification values that ***distinguish among features of the musical composition.*** (See claim 1). The classification values may comprise one or more song attributes. (See claims 2-13).

In contrast to applicants' invention as claimed in claims 1-13, *Easty et al.* is directed a graphical user interface (GUI) for a "menu" that presents the menu as a circular tool bar having concentric rings containing associated content. The menu is arranged such that the outer ring of the circular tool bar contains various categories of digital content (e.g. music, books, etc.) and the inner ring of the circular tool bar operates to display sub-categories of the listed categories displayed in the outer ring of the circular tool bar (e.g. if music is chosen, the inner ring would display the sub-categories: top 40, jazz, etc.). (See Figures 1a-1c of the *Easty et al.* reference).

Accordingly, since Easty *et al.* fails to teach methods and apparatus for use in matching similar or identical musical compositions using a plurality of classification values that ***distinguish among features of the musical composition***, it fails to be anticipatory. On this basis, Applicants respectfully request the withdrawal of the 102(e) rejection in respect to the *Easty et al.* reference.

Katz et al.

Claims 1-13 were rejected under 35 U.S.C. §102(e) as being allegedly anticipated by *Katz et al.*

Applicants respectfully submit that *Katz et al.* does not teach or suggest every limitation of the claims 1-13 of the present invention. Specifically, claims 1-13 of the present application

are directed to an apparatus for use in matching similar or identical musical compositions using a plurality of classification values that ***distinguish among features of the musical composition.*** (See claim 1). The classification values may comprise one or more song attributes. (See claims 2-13).

In contrast to applicants' invention as claimed in claims 1-13, *Katz et al.* is directed to a computing application for use in categorizing, organizing, and sorting multimedia data files originating from one or more multimedia sources (e.g. CD carousel). (See *Summary of the Invention Katz et al.*). The computer application **does not** operate to find similar multimedia files using a plurality of classification values. Stated differently, *Katz et al.* does not "... ***select[ing] the first musical composition from among the plurality of other musical compositions that are similar to the first musical composition***."

Accordingly, since *Katz et al.* fails to teach methods and a apparatus for use in matching similar or identical musical compositions using a plurality of classification values that ***distinguish among features of the musical composition.***, it fails to be anticipatory. On this basis, Applicants respectfully request the withdrawal of the 102(e) rejection in respect to the *Katz et al.* reference.

CONCLUSION

For all the foregoing reasons, Applicant respectfully submits that claims 1-76 stand in condition for allowance. Reconsideration of the present Office Action and an early Notice of Allowance are respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made."

Respectfully submitted,

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Date: **May 2, 2003**

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please amend the claims as follows:

1. (Twice Amended) A computer-readable medium comprising computer readable instructions to instruct a computer to process a data structure stored on the computer-readable medium, wherein the data structure comprises [having] one or more fields containing the information that describes a first musical composition, the computer-readable medium further comprising computer-readable instructions for selecting the first musical composition from among the plurality of other musical compositions that are similar to the first musical composition, wherein the information comprises a plurality of classification values that distinguish among features of the musical compositions.

67. (Amended) A method as recited in claims 66, in which the first object is a pre-recorded motion picture.

68. (Amended) A method as recited in claims 66, in which the first object is a book.

69. (Amended) A method as recited in claims 66, in which the first object is a television program.

70. (Amended) A method as recited in claims 66, in which the first object is a beverage.

71. (Amended) A method as recited in claims 66, in which the first object is a work of art.

72. (Amended) A method as recited in claims 66, in which the first object is a perfume.

73. (Amended) A method as recited in claims 66, in which the first object is a human model.

74. (Amended) A method as recited in claims 66, in which the first object is a game.

75. (Amended) A method as recited in claims 66, in which the first object is a food.

76. (Amended) A method as recited in claims 66, in which the first object is a piece of apparel.